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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AJIT S. SHAH, MADHUKAR THAKUR,
DAVE HU, and JOYCE THOM

Appeal 2008-2941
Application 09/742,699¹
Technology Center 2100

Decided:² March 25, 2009

Before LEE E. BARRETT, JEAN R. HOMERE, and
THU A. DANG, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Filed on December 20, 2000. The real party in interest is PlanetIdeal, Inc.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 27 through 49. Claims 1 through 26 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Appellants' Invention

Appellants invented a method and system for facilitating the electronic exchange of personal information between individuals on a network. (Spec. 8:5-8.) Particularly, Figure 1 depicts an information exchange system (102) including various client platforms (111, 113, 115, 117, 119) that interface with a database (160) via an interface layer (130), an application layer (140), and an exchange engine layer (150). (*Id.* at 5:1-13.) A registered user may provide to a vault (142) in the application layer (140) a request to store personal information. The vault, in turn, queries a virtual record manager (VRM) (154) in the exchange engine layer (150) to actually carry out the request. (*Id.* at 5: 22-24, 6: 17-20.) Further, the registered user utilizes the data exchange engine (156) in the exchange engine layer (150) and permissions data (166) in the database (160) to allow pre-designated registered users to view selected fields of personal information in the user's profile for a defined period of time. (*Id.* at 7: 27- 8:3.) Consequently, when a first registered user requests to access the personal information of a second registered user, the contact manager (148) in the application layer (140) invokes the account manager (152) in the exchange engine layer (150) to

determine which fields in the second user's profile the first user is authorized to access, and thereby limits the user's access accordingly. (*Id.* at 8: 5-16.)

Illustrative Claim

Independent claim 27 further illustrates the invention as follows:

27. An information exchange system comprising:

an engine configured to determine an identity of a first party to be provided personal information, determine whether a selected field of the personal information of a second party can be provided to the first party, and provide the selected field of the personal information of the second party to the first party; and
a database configured to store at least one field of the personal information.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Liu

U.S. 6,216,131 B1

Apr. 10, 2001

Rejection on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 27 through 49 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Liu.

Appellants' Contentions

Appellants argue that Liu's synchronization software that passively waits for a user to enter a name is not configured to consider, investigate or calculate to ascertain the user name of the REX handheld device. Appellants therefore submit that Liu does not teach an engine configured to determine the identity of a first party to be provided personal information, as recited in independent claim 27. (App. Br. 10-11; Reply Br. 4.)

Further, Appellants argue that Liu's processing device that readily maps user information from one data set in a first computer device to another data set in a second computer device is not configured to determine whether the data set about a first computer can be provided to a second computer. Therefore, Appellants submit that Liu does not teach an engine configured to (1) determine whether a selected field of the personal information of a second party can be provided to a first party, and (2) provide the selected field of the personal information of the second party to the first party. (Appeal Br. 13; Reply Br. 5-6.)

Examiner's Findings/Conclusions

The Examiner finds that Liu's disclosure of a synchronization software that recognizes the user name entered in the REX wizard panel as the identification associated with a specific REX card teaches an engine for determining the identity of a first party to be provided personal information, as recited in independent claim 27. (Ans. 10.) Further, the Examiner finds that Liu's disclosure of mapping data fields containing user information, such as user-supplied contact lists, between a PC and the REX system teaches (1) determining whether a selected field of the personal information of a second party can be provided to the first party, and (2) providing the field of the personal information of the second party to the first party, as recited in independent claim 27. (*Id.* at 3-4, 10.) Therefore, the Examiner finds that Liu anticipates claim 27. (*Id.* at 3-4.)

II. ISSUES

Have Appellants shown that the Examiner erred in finding that Liu teaches an engine configured to (1) determine the identity of a first party to be provided personal information, (2) determine whether a selected field of the personal information of a second party can be provided to a first party, and (3) provide the selected field of the personal information of the second party to the first party?

III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Liu

1. As depicted in Figure 1, Liu discloses a method and system for mapping data fields containing user information (e.g. user-supplied contact lists) from a desktop PC (100) to a handheld organizer (REX)(154). (Col. 2, ll. 39, 58-60, col. 5, ll. 26-36.)

2. As shown in Figures 3A-G, the REX handheld device includes a wizard panel (300a) for facilitating the synchronization of the user contact information between the two computers. Particularly, the wizard panel presents a series of prompts to the user to enter and/ or select the necessary information, such as user name, calendar, contact files, memos and preferences that the user wishes to synchronize. REX indicates that the entered username is the identification associated with a specific REX card, and it is used for configuration information. (Col. 5, ll. 36-40.)

3. Upon selecting the synchronize option, the REX system detects and sets up mappings for each cardfile field that the user selected to synchronize, and subsequently synchronizes the selected fields between the two computers according to the synchronization information defined by the user. (Col. 6, ll. 47-55, col. 7, ll. 9-27.)

IV. PRINCIPLES OF LAW

Claim Construction

"[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d at 1323.

Anticipation

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d

1559, 1565 (Fed. Cir. 1992)). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

V. ANALYSIS

Independent claim 27 recites in relevant part an engine configured to (1) determine the identity of a first party to be provided personal information, (2) determine whether a selected field of the personal information of a second party can be provided to a first party, and (3) provide the selected field of the personal information of the second party to the first party.

We first consider the scope and meaning of the terms “*determine*” and “*of*”, which must be given their broadest reasonable interpretation consistent with Appellants’ disclosure, as explained in *In re Morris*, 127 F.3d 1048 (Fed. Cir. 1997):

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

Id. at 1054. *See also In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (stating that “claims must be interpreted as broadly as their terms reasonably allow.”). Appellants’ Specification states the following:

The contact manager 148 manages the information about each registered user's static contacts by storing these in the database 160 and retrieving it when necessary. In contrast, to manage dynamic contacts the contact manager 148 invokes the VRM 154 and the data exchange engine (DXE) 156. The contact manager 148 first invokes the account manager 152 to verify that the user logging in to the system 102 is a registered user and to retrieve the internal account ID of the user.

(Spec. 8: 5-11.)

Our reviewing court further states, “the ‘ordinary meaning’ of a claim term is its meaning to the ordinary artisan after reading the entire patent.” *Phillips v. AWH Corp.*, 415 F.3d at 1321.

Upon reviewing Appellants’ Specification, we fail to find a definition for the claim term “determine” or for the term “of”. We therefore construe cited terms consistently with their ordinary meaning as provided in a dictionary.

The Examiner has not cited any authority as support for construing these terms in the rejection of claims 27 through 49. Appellants, on the other hand, assert that

The American Heritage Dictionary [defines the term “determine” as] “to establish or ascertain definitely, as after consideration, investigation or calculation.”

(App. Br. 9.)

Further, Appellants assert that

The American Heritage Dictionary [defines the term “of” as]
“[w]ith reference to, about.”

(App. Br. 12.)

In the absence of the citation of any broader definition of the terms “determine” and “of” by the Examiner, we will apply the definitions offered by Appellants.

As set forth in the Findings of Facts section, Liu discloses a software program in the REX handheld device including a wizard panel that prompts a user to enter a username associated with a specific REX card. (FF. 2.) Liu further discloses that, for each particular cardfile associated with an entered username, the REX system maps or synchronizes the selected data fields between the desk PC and the REX computer. (FF. 3.) We find that the REX software assigns the entered username to each synchronization session or cardfile in order to ascertain the identity of the session. Therefore, consistent with the adopted definitions above, the REX program determines the identity of each synchronization session between the two computers. We are not persuaded by Appellants’ argument that the personal information being exchanged between the two computers pertains to user’s information as opposed to information pertaining to the PC. Appellants’ attempt to distinguish the claim limitation over Liu based upon the nature of the information as opposed to its function in the claim is unavailing. The nature of the information itself pertains to non-functional descriptive material, which is not entitled to any patentable weight.

We recognize nonetheless that Liu's disclosure does not teach any control mechanism in either the REX system or the PC to enable the computers to selectively restrict access to the data fields that can be synchronized. Thus, we agree with Appellants that Liu does not teach an engine configured to determine whether a selected field of the personal information of a second party can be provided to a first party and providing that selected field of the second party to the first party. It follows that Appellants have shown that the Examiner erred in finding that Liu anticipates independent claim 27.

Because claims 28 through 49 also recite the cited limitations, Appellants have also shown error in the Examiner's rejections of those claims.

VI. CONCLUSION OF LAW

Appellants have shown that the Examiner erred in rejecting claims 27 through 49 as set forth above.

VII. DECISION

We reverse the Examiner's decision to reject claims 27 through 49.

REVERSED

Appeal 2008-2941
Application 09/742,699

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